

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed May 17, 2007. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

Claims 1-20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,604,135, issued to Rogers et al (hereinafter referred to as "Rogers") in view of U.S. Patent Application Publication No. 2002/0073399, published in the name of Golden (hereinafter referred to as "Golden") and further in view of U.S. Patent No 6,732,095, issued to Warshavsky et al (hereinafter referred to as "Warshavsky"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case

of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

The first showing required by MPEP 2143, is that of motivation. In alleging the combination of Golden with Rogers, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made (sic) to combine the teaching of Golden with Rogers reference (sic) because both references are directed to web pages where Rogers is heavily directed to an effective usage of information from databases residing on different servers while Golden focuses on processing, including transforming XML, pages into different languages for outputting document over web to users, the combined teaching would have allowed effective utilization of web information because surfed web pages could have been transformed to a language of user's preference. (Emphasis added)

Though this statement is largely incomprehensible, it does seem that the Examiner alleges motivation based upon enabling Rogers to have "effective utilization of web information". This argument is inadequate as a matter of law, because it is not supported by the prior art of record. There is no showing in the record, except for Applicant's disclosure, that Rogers does not provide "effective utilization of web information" or that the alleged combination would improve "effective utilization of web information" as alleged by the Examiner.

Furthermore, the statement is clearly erroneous, because Rogers states that it provides "effective utilization of web information". Column 1, lines 56-61, of Rogers states:

The invention is related to computers and computer systems and particularly to a method and system for use of the World Wide Web and other sources of information and for utilization of existing equipment advantageously for providing interactive web server data access over networks and the Internet. (Emphasis added)

In other words, one of ordinary skill in the art would not be motivated to make that alleged combination, because Rogers already provides "utilization....advantageously....over....the Internet" without the need to combine with Golden. Thus, the Examiner's apparent attempt to show motivation is inadequate as a matter of law and based upon clearly erroneous findings of fact.

The Examiner has even more difficulty articulating motivation for the further combination with Warshavsky. He states:

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made (sic) to combine the teaching of Warshavsky with Golden and Rogers references (sic) because the references are devoted to markup language documents processing and to retrieving data on a client/server/network environment by browsing and further directed to relational database data conversions, and the combined reference would have enabled a complete web-based system to invoke a seamless flow of large quantities of web surfed documents transforming into pages on languages of user's preference and further mapping and storing into relations database archiving for future utilization where enhanced features of relational database data query and retrieval would have been available for utilizing the archived data.

Again, this statement is largely incomprehensible. Again, it is unsupported by the prior art of record. However, it does appear

that the Examiner finds it necessary to combine Warshavsky with Rogers and Golden to provide "a seamless flow". It seems as though the Examiner has found Rogers and Golden to be incomplete web-based system. It is not understood whether the Examiner has attempted to allege inoperability or lack of enablement of Rogers and/or Golden. In any event, the Examiner has failed to make the required showing of motivation.

The second showing required by MPEP 2143 is that of reasonable likelihood of success. The Examiner has ignored this requirement, because the incompatibilities of Rogers, Golden, and Warshavsky prohibit such a showing.

The third required showing is that of all claim elements being found with the alleged combination. It is clear that the Examiner cannot make this showing by reviewing each of the individual pending claims.

Applicant's invention as disclosed and claimed provides an apparatus for and method of accommodating a service request by a legacy data base management system wherein the service request is embedded in an XML document. The XML document is parsed on an element-by-element basis into an acceptable format for use by the legacy data base management system using information contained in an XML mapping tree. Each element may be accompanied by appropriate attributes. The tree may be saved for future use. The XML document may be defined by a Document Type Definition

(DTD). Thus, it is critical that service request is made using an XML document and that XML document must be converted into a form usable by the legacy data base management system to honor the service request.

The alleged combination of three references cannot meet the claimed limitations because none of the references individually or in combination discloses a service request embedded in an XML document, which must be converted into the native command language script of a legacy data base management system for honoring.

With regard to claim 1, for example. Claim element b requires, "a document containing a plurality of elements formatted in XML (extensible markup language) generated by said user terminal utilizing said customized user interface and transferred from said user terminal to said data base management system which contains said service request". The claimed "service request" is first described in the preamble. That means the claimed "user terminal" uses the claimed "generates the claimed "XML document" which contains the claimed "service request".

The Examiner has found that Rogers discloses a user terminal but does not "teach that the data processing service are provided by execution of an ordered sequence of native command language script", as is required by the preamble. Therefore, the Examiner

alleges the combination with Golden. Yet there is no showing in Golden of the claimed "document containing a plurality of elements formatted in XML....generated by said user terminal utilizing said customized user interface". Thus, the Examiner alleges that because Rogers purportedly has a "user terminal" and Golden purportedly has an XML document, somehow the alleged combination meets the claim limitation. However, even if one were to make the alleged combination, it still would not have the claimed "document containing a plurality of elements formatted in XML....generated by said user terminal utilizing said customized user interface".

It is not enough for the Examiner to simply pile up references containing various pieces of the claimed invention. It is the claimed combination of these elements which is significant in law and in fact.

In addition, the alleged combination of Rogers and Golden admittedly does not disclose the "XML mapping tree stored within said data base management system via which the transformation of each of said plurality of elements is defined which permits conversion of said document to said ordered sequence of native command language script", which is limiting of the third claimed element. Therefore, the Examiner alleges the further combination with Warshavsky.

However, because Warshavsky cannot meet the limitations of claim 1, element c, the Examiner improperly ignores the requirement that the claimed XML mapping tree provides "conversion of said document to said ordered sequence of native command language script". Instead the Examiner emphasizes the conversion into data table elements and omits the claimed resultant, stating:

....the definition is of hierarchical structure whose entities represented by one to many relationships between objects, components, and fields for converting XML document into columns of a record in a relations table is equivalent to Applicant's an XML mapping tree stored within said data base management system via which the transformation of each of said plurality of elements is defined which permits conversion of said document to said ordered sequence of native command language script. (Emphasis added)

Thus, in order to reject Applicant's claim, the Examiner states, "columns of a record in a relations table is equivalent to....ordered sequence of native command language script". Not only is this statement clearly erroneous, it is improper as a matter of law. The rejection of claim 1, and all claims depending therefrom, is respectfully traversed as having been improperly examined as a matter of law.

Claim 6 is an independent apparatus claim having five limiting elements. Again, the Examiner admits that the prior art of record does not have the limitations of claimed element e, so he ignores it and improperly addresses element c of claim 1. He concludes his rejection by legally irrelevantly and clearly

erroneously finding that Warshavsky meets the limitations of claim 1, element c. The rejection of claim 6, and all claims depending therefrom is respectfully traversed as having been improperly examined as a matter of law.

Claim 11 is an independent claim for "a method of using an XML document to define a service request to a data base management system having an incompatible input protocol including an ordered sequence of command language statements for execution by said data base management system to honor said service request", wherein the method has five steps as limiting elements. The Examiner admits that the prior art of record in general and the alleged combination in particular does not teach this method. Though the Examiner alleges that Rogers shows a "service request", he admits that the service request is not defined by an "XML document". The Examiner alleges that Golden does not have the claimed "service request" but shows an "XML document".

Finally, the Examiner admits that neither Rogers, nor Golden, nor the combination thereof discloses the claimed conversion. Therefore, the Examiner cites Warshavsky which is alleged to disclose the conversion process. However, as the Examiner admits, the Examiner does not convert the XML document to the claimed "service request" which is compatible with the claimed legacy data base management system. Warshavsky only extracts data from within the XML document.

Therefore, because the final step, "presenting said parsed XML document as said ordered sequence of command language statements to said data base management system for processing by execution" is nowhere to be found in the alleged combination, the Examiner cannot cite anything but the disparate portions of Golden, Figs. 8-9 and paragraphs 0038, 0389, and 0392, which do not relate to each other much less relate to the claimed element. The rejection of claim 11, and all claims depending therefrom is respectfully traversed.

Claim 16 is an independent apparatus claim having four "means-plus-function" elements. The first element is "creating means for creating an XML document defining a service request utilizing a customized user interface". The Examiner admits that the prior art does not contain this element. Whereas the Examiner alleges that Rogers creates a "service request", it is admitted that Rogers does not create the "service request" as an XML document. Furthermore, the Examiner alleges that Golden teaches "using an XML document", but not the claimed "service request" contained within the claimed "XML document" or the claimed "creating means". As a result, the alleged combination does not have the claimed "creating means".

Having admitted that the alleged combination does not have the claimed "creating means", the alleged combination cannot have the second element, "transmitting means" responsively coupled to

the "creating means" as claimed. Thus, the allegation that Golden has the claimed "transmitting means" is clearly erroneous.

The third claimed element is "providing means responsively coupled to said transmitting means for providing data base management functions to honor said service request and for providing a portion of said customized user interface to said creating means". Notwithstanding the Examiner's admission that Golden does not have the claimed "customized user interface" or the claimed "creating means", he nevertheless clearly erroneously states that Golden somehow have the claimed third element.

The fourth claimed element is "composing means responsively coupled to said providing means for composing said XML document from an XML mapping tree and data in said data base management system". The claimed element is "for composing said XML document". Ignoring Applicant's claimed invention, the Examiner cites material from Warshavsky "for converting XML document into columns of a record in a relational table". In other words, instead of the claimed means for composing an XML document, the Examiner cites Warshavsky to show converting an XML document into columns of a record in a relational table. This finding is legally irrelevant, because it does not address Applicant's claimed invention.

The rejection of claim 16, and all claims depending therefrom, is respectfully traversed for failure of the Examiner

to make any of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness.

Claims 2, 8, 14, and 18 depend from claims 1, 7, 13, and 17, respectively and further limits the claimed XML document having a service request located therein. Because the alleged combination does not have the claimed XML document, the Examiner clearly erroneously cites Warshavsky, column 1, lines 35-49, which does not relate to the claimed invention. The rejection of claims 2, 8, 14, and 18 is respectfully traversed.

Claims 3 and 13 depend from claims 2 and 12, respectively and further limits the claimed XML document having a service request located therein. Because the alleged combination does not have the claimed XML document, the Examiner clearly erroneously cites Warshavsky, column 1, lines 50-57, which does not relate to the claimed invention. The rejection of claims 3 and 13 is respectfully traversed.

Claims 4, 7, 12, and 17 depend from claims 3, 6, 11, and 16, respectively, and further limit storage of the claimed "XML mapping tree" for "future use". Because the alleged combination has no such structure, the Examiner simply ignores the requirement to store for "future use". The rejection of claims 4, 7, 12, and 17 is respectfully traversed for failure of the Examiner to address Applicant's claimed invention.

Claims 5 and 20 depend from claims 4 and 19, respectively, and is further limited to "displaying" the XML tree at the claimed "user terminal". The Examiner cites Golden paragraph 0038, even though he has explicitly admitted that Golden has no XML tree (see rejection of claim 1, element c). Furthermore, the Examiner cites Warshavsky having admitted that the reference has no "user terminal" as claimed. Clearly, the Examiner's citations are legally irrelevant. Therefore, the rejection of claims 5 and 20 is respectfully traversed as being legally irrelevant for not having addressed Applicant's claimed invention.

Claims 9, 15, and 19 depend from claims 8, 14, and 18, respectively, and further limits the claimed coupling network. In making his rejection, the Examiner state:

See Golden: [0387] where XML is received over internet. This statement is clearly erroneous and unsupported by the cited paragraph. Paragraph 0387 mentions an "HTTP request over the Internet". Furthermore the paragraph refers to Fig. 7 which shows that the only input is "html". The rejection of claims 9, 15, and 19 is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 10 depends from claim 9 and further limits the claimed XML mapping tree. As explained above, the alleged combination does not meet the limitations of claim 9 from which claim 10 depends. Therefore, the alleged combination cannot meet the

further limitations of claim 10. The rejection of claim 10 is respectfully traversed.

Claims 21-22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers in view of Golden. This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

The Examiner's attempt at showing motivation to combine Golden with Rogers is inadequate as a matter of law for the reasons provided above. The Examiner again ignores his obligation to show reasonable likelihood of success.

With regard to the requirement to show all claimed elements, claim 21 is an independent apparatus claim having three major limiting elements. Before actually applying the prior art, the Examiner irrelevantly states:

As per claim 21, Rogers teaches an apparatus "for controlling a legacy database management system"...

This statement is irrelevant, because it does not address Applicant's claimed invention. Furthermore, to the extent that the Examiner utilizes such irrelevant findings to apply the prior art, it is impermissible as a matter of law.

Similarly, the Examiner states:

Please note Examiner interprets any established database under maintenance mode is a legacy database system.

Again, the statement is at least legally irrelevant, because it does not address Applicant's claimed invention. Use of such an irrelevant statement in applying the prior art is inconsistent with controlling law. The Examiner is required to examine Applicant's claimed invention rather than some sort of paraphrase of Applicant's claims.

The first limiting element is "a user terminal having a customized user interface with which said user terminal generates a database management system service request as said XML message". In making his rejection, the Examiner cites Golden, Figs. 8-9 and paragraphs 0026, 0038, 0389, and 0392. Neither cited figure and none of the four cited even mentions a "user terminal". Thus, it can only be assumed that the Examiner has not found the first claimed element within the prior art of record.

Having previously pointed this out to the Examiner, he has responded stating:

....where XML input streams, including XML message, generated at user interface is transferred to an XBF engine, XML Behaviour Framework, formatted into XML document, processed and tags parsed for accessing relational database is equivalent to Applicant's a user terminal having a customized user interface with which said user terminal generates a database management system service request as said XML message. (Emphasis added)

Thus, the Examiner appears to be unable of distinguishing between "XML input streams" of Golden and Applicant's claimed "user

terminal". Surely one of skill in the art can distinguish between a stream of data and a physical piece of hardware called a "user terminal".

The second limiting element is "said legacy database management system responsively coupled to said user terminal via a publicly accessible digital data communication network which stores components of said customized user interface and which transfers said components of said customized user interface to said user terminal for generating said service request as said XML message and which honors said service request by executing an ordered sequence of command language script". The Examiner again cites Golden, Figs. 8-9, and paragraphs 0038, 0389, and 0392. And again, there is no mention of the claimed "legacy database management system", the claimed "user terminal", the claimed "publicly accessible digital data communication network", the claimed stored "components of said customized user interface", the claimed transfer of the components, etc. Therefore, it can only be assumed that the Examiner has not found the second claimed element within the prior art of record.

The third claimed element is "a conversion facility responsively coupled to said legacy database management system which parses said XML message to produce said ordered sequence of command language script". The Examiner again cites the same material from Golden, which makes no mention of the limitations

of the third claimed element. Again, it must be assumed that claim element three cannot be found in the prior art of record.

Thus, the rejection of claim 21, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to make any of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness.

Claim 22 depends from claim 21 and is further limited by "wherein said XML message further comprises a plurality of elements". The Examiner again cites the same material from Golden which says nothing of Applicant's invention as claimed. The rejection of claim 22 is respectfully traversed.

Claims 23-25 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers in view of Golden and further in view of Warshavsky. This ground of rejection is respectfully traversed for the reason provided below.

The alleged motivation is inadequate as a matter of law for the reasons discussed in detail above. The Examiner again ignores his responsibility to show reasonable likelihood of success.

Claim 23 depends from claim 22 and is further limited by "wherein said conversion facility further comprises an element to source mapping tree". The Examiner clearly erroneously finds that this limitation is found in Warshavsky. He cites column 4,

lines 52-57, which does not support his finding. Therefore, the rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and is further limited by "a repository wherein said element to source mapping tree is stored for future use". The Examiner makes four citations to Warshavsky, none of which mentioning saving the claimed "source mapping tree" for "future use". The rejection of claim 24 is respectfully traversed.

Claim 25 depends from claim 24 and further limits the claimed coupling network. In making his rejection, the Examiner state:

See Golden: [0387] where XML is received over internet. This statement is clearly erroneous and unsupported by the cited paragraph. Paragraph 0387 mentions an "HTTP request over the Internet". Furthermore the paragraph refers to Fig. 7 which shows that the only input is "html". The rejection of claim 25 is respectfully traversed as based upon clearly erroneous findings of fact.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

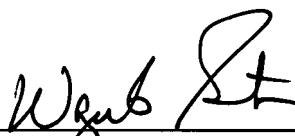
Please charge any deficiencies or credit any overpayment to
Deposit Account No. 14-0620.

Respectfully submitted,

Thomas N. Turba

By his attorney,

Date August 17, 2007


Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, MN 55413
(612) 331-1464